

REMARKS

Claims 1-36 are presented for examination.

Claims 10-18 and 36 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. But claims 10 and 36 are clear on their face. Claim 10, as originally filed, recites electronics for generating a corrected data set and electronics for printing a code. These electronics can be different, but need not be different. Claim 36, which recites "electronics different than the laser for printing pixels on the product" is also clear on its face. Examples of the electronics are electronics 26 described in the specification, e.g., page 10, line 20. Applicants request that the rejection under § 112 be reconsidered and withdrawn.

Claims 1-33 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,061,081 (Hasebe) in view of U.S. Patent No. 5,329,090 (Woelki). The Examiner acknowledged that Hasebe does not teach a code being rendered by substantially discrete marks corresponding to pixels, and thus needed to combine Woelki with Hasebe to address the deficiency. As the sole support for the combination, the Examiner stated that a person of ordinary skill would have modified the device of Hasebe with the teaching of Woelki "for the purpose of inscribing easily readable marking on the product."

But Hasebe does not suggest any motivation that would lead a person of ordinary skill to modify the devices. On the contrary, Hasebe expressly and repeatedly indicates that its devices include functionalities, for example, focusing a laser beam within a target area or changing the scanning speeds, such that "a mark high in picture quality can be inscribed on the workpiece." (See, e.g., Hasebe col. 3, lines 54-58; col. 7, lines 42-47; and col. 7, lines 58-62.) Therefore, since Hasebe teaches that readable markings can be inscribed, a person skilled in the art reading Hasebe would not be motivated to modify Hasebe's devices with the teachings of Woelki.

The Examiner is reminded that to establish obviousness based on a combination of references, there must be a reason, suggestion, or motivation to lead an inventor to combine those references. Here, the Examiner's only motivation for combining the references ("for the purpose of inscribing easily readable marking on the product") is refuted by the clear indication that Hasebe's devices provide "a mark high in picture quality". The rejection, if maintained,

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would be based on improper hindsight analysis. Applicants request that the rejection be reconsidered and withdrawn.

Claims 34 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasebe in view of U.S. Patent No. 5,175,425 (Spratte). The Examiner's only support for combining the references is that a person of ordinary skill would modify Hasebe's device "for the purpose of providing a high resolution code on the surface of the object to be marked." But, as discussed above, Hasebe already teaches features that provide marks high in picture quality, and therefore, a person skilled in the art reading Hasebe would not be motivated to modify Hasebe's devices. Applicants request that the rejection be reconsidered and withdrawn.

Applicants believe the claims are in condition for allowance, which action is requested.